



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/759,732	01/15/2004	Oren A. Mosher		6876

34205 7590 06/05/2007
OPPENHEIMER WOLFF & DONNELLY LLP
45 SOUTH SEVENTH STREET, SUITE 3300
MINNEAPOLIS, MN 55402

EXAMINER

GIBSON, ROY DEAN

ART UNIT	PAPER NUMBER
----------	--------------

3739

MAIL DATE	DELIVERY MODE
-----------	---------------

06/05/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/759,732

Applicant(s)

MOSHER ET AL.

Examiner

Roy D. Gibson

Art Unit

3739

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 March 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17, 19-21, 23-28 and 36-44 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-17 and 19-21 is/are allowed.
- 6) ☒ Claim(s) 23-28 and 36-44 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Formal Matters

The presentation of common ownership of Patent Nos. 6,091,995 and 6,216,704 results in the withdrawal of the 103 rejections of claims 1-17 and 19-22. However, since the common ownership does not remove the bar of the 102 rejections of claims 23-28 and 36-44, these rejections are maintained as presented below.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 23-28 and 36-44 are rejected under 35 U.S.C. 102(b) as being anticipated by Ingle et al. (U.S. Patent No. 6,091,995 and 6,216,704). The following rejections refer to P/N 6,216,704:

In regards to Claim 23, Ingle et al. discloses a system for treating incontinence comprising "a probe body" (See Figure 5, # 42) and that "at least one energy delivery element" (electrodes 12 a-d).

P/N 6,216,704 discloses various embodiments that have treatment volumes greater than 300 cu. mm (see Figure 5, where the tip diameter can be 4 cm, providing an electrode width of about 20-30 mm and the electrode length is estimated as 10 mm

Art Unit: 3739

resulting in a treatment volume of about 540 –800 cu. mm if the treatment depth is about 2.8 mm).

In regards to Claim 24, Ingle et al. ('704) discloses a system for treating incontinence (See Claim 23 Rejection). Ingle et al. further discloses, "at least one cooling element supported by the probe body" (See column 18, lines 18-21).

In regards to Claim 25, Ingle et al. discloses a system for treating incontinence (See Claim 24 Rejection). Ingle et al. further discloses, "at least one energy delivery element comprises a plurality of electrodes (12)". (See column 18, lines 18-21).

In regards to Claim 26, Ingle et al. discloses a system for treating incontinence (See Claim 25 Rejection). Ingle et al. further discloses, "the electrodes have a width of at least 20 mm and a length of about 10 mm (or about 8 mm).

In regards to Claim 27, Ingle et al. discloses a system for treating incontinence (See Claim 25 Rejection). Ingle et al. further discloses, "at least one energy delivery element comprises a distal or proximal pair of electrodes on the probe body" (See Figure 5 , elements 12).

In regards to Claim 28, Ingle et al. discloses a system for treating incontinence (See Claim 24 Rejection). Ingle et al. further discloses, "at least one energy delivery element comprises a pair of elongated electrodes" (See Figure 5, elements 12a and 12b).

In regards to Claims 38, 39, 40 and 43, Ingle et al. discloses a system for treating incontinence (See Claim 23 Rejection). It is the Examiner's position that Ingle et al. is inherently capable of meeting these functional limitations.

In regards to Claims 41 and 42, Ingle et al. discloses a system for treating incontinence (See Claim 23 Rejection). It is the Examiner's position that Ingle et al. is inherently capable of meeting these functional limitations.

In regards to Claim 44, Ingle et al. discloses a system for treating incontinence (See Claim 23 Rejection). Ingle et al. further discloses "at least one energy delivery element heats the treatment volume of tissue by the application of bipolar radio frequency energy" (See column 17, lines 24-40).

Allowable Subject Matter

Claims 1-17 and 19-21 are allowed.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any


Art Unit: 3739

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Roy D. Gibson whose telephone number is 571-272-4767. The examiner can normally be reached on Tu-Th, 7:30 am-4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda Dvorak can be reached on 571-272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Roy D. Gibson
Primary Examiner
Art Unit 3739

May 30, 2007